REMARKS

Claims 1-17 are pending in this application. Claims 1, 4, 13, and 17 are independent. In light of the remarks made herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected 1-3, 5, and 17 under 35 U.S.C. § 103(a) as being unpatentable over Noguchi et al. (USP 4,978,980); and rejected claims 4 and 6-16 under 35 U.S.C. § 103(a) as being unpatentable over Noguchi et al. in view of Yasui et al. (USP 5,839,032). Applicants respectfully traverse these rejections.

Claims Rejections – 35 U.S.C. § 103(a) – Noguchi et al.

In support of the Examiner's rejection of claim 1, the Examiner admits that *Noguchi et al.* fails to teach the rotation of the intermediate roller being in synchronism with a resumption of rotation of the resist roller. The Examiner asserts it would have been obvious to one of ordinary skill to provide for this missing element, presumably asserting that if this element were not present, the device would jam. Applicants respectfully disagree with the Examiner's assertions.

In order to sustain a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner admits that *Noguchi et al.* fails to teach the intermediate roller being in synchronism with a resumption of rotation of the resist roller. However, the Examiner fails to provide references that cure the deficiencies of the teachings of *Noguchi et al.* As such, the Examiner has failed to establish *prima facie* obviousness by failing to provide references that teach or suggest all of the claim elements. For at least this reason, the outstanding rejection should be withdrawn.

In addition to the above argument, Applicants are confused by the Examiner's statements regarding *Noguchi et al.* The Examiner asserts that *Noguchi et al.* teaches an intermediate roller 515 and a resist roller 405, citing to Figs. 21 and 22. However, there is no reference number 405 depicted in either Fig. 21 or Fig. 22. Roller 405 is depicted at least in Fig. 20. *Noguchi et al.* describes that the device in Fig. 20 is a different recording apparatus than that depicted in Figs. 21 and 22. As such, the Examiner's reliance on reference 405 in Fig. 20, coupled with the description set forth in Fig. 22 as explained in the outstanding Official Action, is wholly inappropriate.

Further, Applicants respectfully disagree that image forming means 505 (405) teaches the resist roller of the claimed invention. The present invention set forth in claim 1 recites a resist roller for synchronizing a timing at which a sheet is transferred onto the first sheet transferring path. There is no teaching or suggestion in *Noguchi et al.* that indicates that image forming means 505 performs this function as set forth in claim 1. As such, Applicants maintain that *Noguchi et al.* fails to teach or suggest this claim element. For at least this reason, Applicants respectfully request that the outstanding rejection be withdrawn.

Further, the Examiner appears to indicate that it would have been obvious to one skilled in the art to provide the missing element as indicated, presumably asserting that if the element were not present, the device would jam. *Noguchi et al.* is a United States patent issued on December 18, 1990. Presumably, the device disclosed in *Noguchi et al.* satisfies all of requirements under 35 U.S.C. § 112. As such, there is a presumption that the device works. Therefore, the Examiner's assertion that if the feature was not present then the device would jam is an improper presumption. If, in fact, the device disclosed in *Noguchi et al.*, is a non-working device as asserted by the Examiner, then Applicants respectfully submit that the Examiner's citation of *Noguchi et al.*, is improper as it represents a non-working device and thus is not sufficiently enabled to teach the features as asserted by the Examiner.

In addition to the above arguments, the Examiner admits that *Noguchi et al.* fails to teach or suggest an intermediate roller which is in synchronism with a resumption of rotation of the resist roller. In order for a *prima facie* case to exist, the prior art must suggest the desirability of

the claimed invention, providing motivation to make the combination proposed by the Examiner. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ 2d1453, 1457-58 (Fed.Cir. 1998). The level of skill in the art cannot be relied upon to provide this suggestion to combine the references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). As *Noguchi et al.* fails to teach or suggest this element, by asserting such a modification to the device disclosed in *Noguchi et al.* would have been obvious without a proper suggestion or motivation in the applied reference or elsewhere to do so, the rejection appears to rely on impermissible hindsight reasoning. As such, for at least this reason, Applicant's respectfully request that the outstanding rejection be withdrawn.

For all of the reasons set forth above, the Applicants maintain that the Examiner has failed to establish *prima facie* obviousness. As such, it is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2 -3, 5-8, and 12 are allowable for the reasons set forth above with regard claim 1 at least based upon their dependency on claim 1. It is further respectfully submitted that claim 17 contains elements similar to those discussed above with regard to claim 1 and thus claim 17 is not obvious for the reasons set forth above with regard to claim 1.

Claim Rejections - 35 U.S.C. § 103 - *Noguchi et al./Yasui et al.*

The Examiner rejected claims 4 and 6-16 under 35 U.S.C. § 103(a) as being unpatentable over *Noguchi et al.* in view of *Yasui et al.* In support of this assertion, the Examiner merely provides support for his rejection of claim 4. The Examiner provides some statement regarding what would be obvious with regard to claims 6-17 (claim 17 did not appear to be rejected in view of *Noguchi et al.* and *Yasui et al.*) but fails to particularly identify which references he is relying upon to teach or suggest each of the individual elements of the claims. Applicants maintain that *Noguchi et al.* fails to teach or suggest the intermediate roller and the resist roller for the reasons noted above with regard to claim 1. Further, the Examiner has failed to establish *prima facie* obviousness by failing to provide references that teach or suggest all of the claim elements as noted above with regard to claim 1. Finally, as the Examiner has failed to provide any details

with regard to the elements set forth in each of claims 6-16, Applicants are unable to properly address the Examiner's rejections. Applicants respectfully request that should the Examiner maintain the rejection as set forth, that the Examiner provide a proper rejection specifically setting forth which of the references and what portions of the references he is relying upon to make his *prima facie* case of obviousness in a new, non-final official action so that Applicants may properly respond.

Conclusion

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By _____

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